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REMARKS

The application comprises claims 1-38, 40-44, 46-47 and 57-65 of which claims 59-62 are rejected and claims 63-65 are new. Claims 1-38, 40-44, 46-47 and 57-58 are allowed.

35 USC §101

Claims 59-62 are rejected under 35 USC §101 as being directed to non-statutory subject matter. Specifically, Examiner has indicated that no machine or machine related steps are recited. Furthermore, the Examiner has characterized the steps of the methods as being capable of performance by the human mind. Applicants disagree with the Examiner that a machine or machine related steps are necessary in order for a method to be statutory, and further that all of the steps of the methods are capable of being performed by the human mind.

Regarding the Examiner's first assertion, it is settled law that a computer related process is considered statutory if: (A) it results in a physical transformation outside the computer or (B) is limited to a practical application within the technological arts. See Diamond v. Diehr, 450 US at 183-184 and MPEP §2106. A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result. See AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352 (Fed. Cir. 1999) and State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F. 3d 1368 (Fed. Cir. 1998). In the present claims 59-62, a concrete, tangible and useful result is produced. To wit, relevant search results are generated based at least in part on an analysis of their interconnectivity to other relevant results.

In addition to the above, not all of the steps of the methods of claims 59-61 are capable of performance by the human mind. For example, in claim 59 an initial set of documents is obtained. These documents do not already exist in the human mind otherwise this would not be a method of generating them. Therefore, they are drawn from somewhere else and are not a mental step.

With respect to claim 60, a limited set of pages including links to a limited list of search results is generated. Again, if this were a mental process no generation would be necessary as they would already exist within the human mind. Furthermore, "pages" would not exist mentally.

With respect to claim 61, as with claim 60, a limited set of pages including links to a limited list of search results is generated. If this were a mental process no generation would be necessary as they would already exist within the human mind. In addition, "pages" (and possibly links) do not exist mentally.

While the Applicants disagree with the Examiner, Applicants have added dependent claims to recite that the methods are "computer-implemented". Applicants note for the Examiner

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that claims 59 and 60 have already been deemed as statutory matter by the USPTO as they are identical to the issued claims 1 and 12 of US Patent 6,725,259.

35 USC §112

Claims 59-62 are rejected under 35 USC §112 as failing to comply with the written description requirement. Applicants respectfully disagree with Examiner, as all essential elements of the claims or their equivalents are described in the specification as filed.

Prior to discussing each limitation to be found in claims 59-62, Applicants would like to explain the interrelationship between "site" and "document". A site located on the Internet contains graphics, text, audio, video and other dynamic and static materials, see the attached Exhibit A. A document in the context of the Internet is a file that contains text, media, or hyperlinks that can be transferred from a server to a client, see attached Exhibit B. Often, a single document contains all of these materials at a site. As a result, "page", "document" and "site" are often used interchangeably when speaking in the context of the Internet. For example, a file called "index.html" could be considered a document; however, it is also the most likely the homepage for a site, or perhaps the site in its entirety. The term "site" is used extensively, but not exclusively, in the present application to describe searching on the Internet.

The following are exemplary, but not necessarily limiting support for the claims at issue:

Regarding Claim 59:

Preamble- support can be found in the present application at page 9, lines 16-17 which describes that a list of sites (e.g., documents) can be generated using several search methods.

First limitation- support can be found in the present application at page 9, lines 31-34 and page 10, lines 1-5 where it is described that an initial number of documents is returned in response to a search (122).

Second limitation- support can be found at page 10, lines 6-26 where it is taught that a rank (e.g., score) is assigned to certain sites based on cross references between the sites, see especially line 16 with regards to the cross referencing and lines 22-26 for an exemplary method of ranking/scoring.

Third limitation- support can be found at page 10, lines 22-34 and page 11, lines 1-7 where it is described that once the documents are ranked, they are sorted and/or filtered based on their rank, among other optional factors. Various filtering methods are also described on page 13, lines 7-34 and page 14, lines 1-15.

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Regarding Claim 60:

Preamble- support for a method of responding to a search query from a user can be found at page 9, line 29-page 12, line 20.

First limitation- support can be found at page 9, line 31 which describes the user performing a keyword search.

Second limitation- support can be found in the present application at page 9, lines 31-34 and page 10, lines 1-5 where it is described that a list of relevant documents is returned in response to a search (122).

Third limitation- support can be found at page 10, lines 6-26 where it is taught that a rank (e.g., score) is assigned to certain sites based on cross references between the sites, see especially line 16 with regards to the cross referencing and lines 22-26 for an exemplary method of ranking/scoring.

Fourth limitation- support can be found at page 10, lines 22-34 and page 11, lines 1-7 where it is described that once the documents are ranked, they are sorted and/or filtered based on their rank, among other optional factors. Various filtering methods are also described on page 13, lines 7-34 and page 14, lines 1-15.

Regarding Claim 61:

Preamble- support for provided search results can be found on page 11, line 8 where a list of search results is provided to a user.

First limitation- support can be found at page 9, line 31 which describes the user providing a keyword as a search term.

Second limitation- support can be found in the present application at page 9, lines 31-34 and page 10, lines 1-5 where it is described that a list of relevant documents is returned which is indexed to the search term.

Third limitation- support can be found for generating a limited set of pages, or a group, including links to the limited list of sites which are indexed to the original search term at page 9, lines 31-35 and page 10, lines 1-21, where it is described that a search term is used to generate an initial list of sites, which may then be put in a limited list (page 10, line 6 "grouping") where the grouped sites include links to each other (page 10, lines 16-17).

Fourth limitation- support for the generation of a set of search results from the limited list can be found on page 11, lines 8-9 where it is described that a list of links is presented to a user.

Regarding Claim 62:

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First limitation- support can be found in the present application at page 9, lines 31-34 and page 10, lines 1-5 where it is described that a list of relevant documents is returned in response to a search for a search term (keyword) and that filtering can be performed to provide a limited set of pages.

35 USC §102(b)

Claims 59-62 are rejected under 35 USC §102(b) as being anticipated by US Patent 6,421,675 to *Ryan, et al.* ("the '675 patent"). Applicants disagree with the Examiner that claims 59-62 are anticipated by the '675 patent because the Examiner has failed to establish a *prima facie* case for anticipation under §102(b).

First, 35 USC §102(b) does not apply in this case. This section states that a person is entitled to a patent unless the invention was patented or described in a printed publication more than one year prior to the application date of this application. This application was filed on June 29, 2000. The '675 patent was not patented until 2002, therefore it was not patented more than one year prior to the application date of this application. Furthermore, patent applications were not published by the USPTO at the time the '675 patent was pending, and therefore it was not described in a printed publication more than one year prior to the application date of this application. If the Examiner has evidence to the contrary, it hasn't been provided. Therefore, there is also no support for the contention that it was described in a printed publication more than one year prior to the filing of this application.

Notwithstanding the above, not all of the elements of claims 59-60 are described by the '675 patent. Claims 59 and 60 indicate that relevance scores are assigned to search results based on cross references between the results. In contrast, the '675 patent assigns relevance based on measured user behavior in response to particular search results. See column 9, lines 16-34, specifically lines 31-34. This is the crux of the '675 invention. Therefore, claims 59 and 60 are not anticipated by the '675 patent since search result relevance is determined differently.

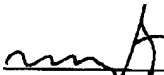
Regarding claims 61-62, the Examiner has not shown where in the '675 patent a limited set of pages including links to a limited list of results is generated. Furthermore, the subsequent step of generating a set of search results responsive to the number of links from the limited set of pages to the limited list of results is also not described in the '675 patent. As a result, claim 61 is not anticipated and neither is its dependent claim 62.

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In view of the foregoing amendments and arguments, Applicants believe the claims are in a condition for allowance. Notice to this effect is respectfully requested.

If the Examiner is unable to agree that the claims are all patentable, he is respectfully requested to contact Maier Fenster at toll free 1 (877) 428-5468. This number connects directly to our office in Israel. Please note that Israel is 7 hours ahead of Washington, D.C. and that our work week is Sunday-Thursday.

Respectfully submitted,
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